



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,125	04/11/2001	Geoffrey S. Goedde		1586

7590 06/19/2006
TransPotomac Plaza
1033 N. Fairfax St., Suite 306
Alexandria, VA 22314

EXAMINER

KESACK, DANIEL

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/832,125		GOEDDE, GEOFFREY S.	
	Examiner		Art Unit	
	Dan Kesack		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 1,5 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-19 are currently pending.
The rejections are as stated below.

Specification

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. *Vas-Cat, Inc. v. Mahurkar*, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims.

The specification does not reasonably provide enablement for providing a software settlement system. The step of "providing a software settlement system"

Art Unit: 3624

presumably includes a distribution, or steps which make the software system available, however the specification provides no such enablement, and it is therefore unclear how this step is performed. Therefore, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claim Objections

3. Claim 1 is objected to because of the following informalities: step (d) contains a grammatical error. Examiner respectfully suggests changing line 2 of step (d) to "remuneration due to each party in the transaction." Appropriate correction is required.

4. Claim 5 is objected to because of the following informalities: claim 5 contains grammatical errors. For the purposes of examination, Examiner has assumed an unintentional omission of the word "is" between "calculation" and "based". Appropriate correction is required.

Claim 14 is objected to because of the following informalities: the term "ACH" must be clearly defined within the claim to mean "automated clearing house" which Examiner assumes is intended by the abbreviation. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph for the reasons set forth in the objection to the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 6, 8, 15, 16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "at the appropriate time" renders the claim indefinite, because it is unclear from the claim language what time Applicant considers to be "appropriate."

Regarding claims 2-4, 9-12, the phrase "can be" renders the claim indefinite because the claim language does not clearly define whether or not the claimed invention includes the recited limitation.

Regarding claim 6, the phrase “may be” renders the claim indefinite because the claim language does not clearly define whether or not the claimed invention includes the recited limitation.

Regarding claims 6 and 18, the claims recite, “whereby said database may be of any type of data repository including SQL or ASCII.” It is unclear whether SQL and ASCII are offered as examples of types of data repositories which the database may be made of, or if the data repository must include at least of one either SQL or ASCII. In the case of the latter, it is further unclear how a data repository can include SQL or ASCII. Examiner notes that the data repository may support a standard such as ASCII, and may be programmed with a language such as SQL, but it is unclear what Applicant intends by the phrase “includes SQL or ASCII”

Regarding claim 8, it is unclear how a link is defined by a web site, as claimed. Since the word “link” may have multiple meanings in the specified environment, the claim is indefinite because one is unable to ascertain how a “credit authorization comprises communicating with a server based on a link defined by said web site to obtain the credit approval for the transaction”.

Regarding claim 15, Applicant’s use of parenthesis renders the claim indefinite. Specifically, it is unclear whether the inclusion of “(software)” is intended to offer an example of an interactive programming language, or serve as an alternate terminology

of such. Examiner is unable to determine whether "software" must be present to meet the scope of the claim, therefore rendering the claim indefinite.

Regarding claim 16, the term "interactive programming language" lacks antecedent basis in preceding claim 13 from which it depends. This lack of antecedent basis renders the claim indefinite.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martizen et al., U.S. Patent No. 5,987,429, in view of Nagata et al., U.S. Patent No. 4,594,663.

Claims 1, 8, 13, 19, Martizen discloses a computer-based fee processing for electronic commerce, comprising purchasing an item (column 1 lines 18-19), creating an account to remit the appropriate funds (figure 4, #56), processing and automatically calculating the exact remuneration due to each party in the transaction and directing transfer of the appropriate funds to each party of the transaction at the appropriate time (column 2 lines 40-65).

Martizen fails to teach requesting credit approval and upon arrival funds are transferred into a merchant account or series of merchant accounts.

Nagata discloses a credit transaction processing system wherein a credit transaction is initiated at a terminal, the terminal requests and obtains credit approval, and funds are transferred into a merchant account or a series of merchant accounts (figure 6 and column 7 lines 1-43). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Martizen to include the credit transaction processing steps of Nagata because the system of Martizen processes credit cards for payments as part of the transactions, and credit card transactions must be approved, and the funds distributed to the appropriate accounts in order for fees to be processed and remunerated.

Claim 2, Martizen teaches the system is network-based (figure 1).

Claim 3, Martizen teaches the system being used by ecommerce trading partners (column 5 lines 26-36).

Claim 4, Martizen teaches the purchase of an item can be made with a credit card (column 5 lines 26-36).

Claim 5, 17, Martizen teaches the automatic calculation is based on a set of pre-established business rules or agreements, where these relationships are stored in a database on at least one server (column 6 lines 52-58).

Claim 6, 18, Martizen teaches the relationships are stored in a database (column 6 lines 52-58), and databases are inherently data repositories.

Claim 6, 18, Martizen fails to teach the data repository including SQL or ASCII.

Official Notice is taken that the use of ASCII and SQL in a database is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Martizen to include the use of ASCII or SQL because a database must include programming and ASCII and SQL are well-known programming methods and standards for interacting in a database environment.

Claim 7, Martizen teaches the transfer of funds is performed electronically (column 8 lines 47-50).

Claims 9-12, Martizen inherently teaches the appropriate party can be an online merchant, product manufacturer, service provider, shipping agent, federal, state or local authority (column 5 lines 26-60). Furthermore, these claims are regarded as intended use, and do not affect the structure of the method claimed, and do not further define the method claimed, and therefore do not represent positive patentable limitations as claimed.

Claims 15, 16, Martizen teaches the network system is controlled by an interactive programming language installed on the system operator's server and accessible by remote sites (column 3 line 52 – column 4 line 28).

Martizen fails to teach the programming languages comprising Java and C++.

Official notice is taken that the use of Java and C++ as interactive programming languages is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Martizen to include the use of Java and C++ because programming language is a matter of design choice and Java and C++ are well known languages capable of implementing the sequence of steps as taught by Martizen (column 3 lines 52-63).

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martizen and Nagata as applied to claim 13 above, and further in view of Gryglewicz et al., U.S. Patent No. 6,993,502.

Martizen and Nagata fail to teach the use of an ACH system.

Gryglewicz teaches using an ACH system to calculate and transfer appropriate tax fees involved in a transaction (column 9 line 43 – column 10 line 13). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Martizen and Nagata to include the ACH system of Gryglewicz because Martizen teaches collecting tax fees from transaction amounts, and Gryglewicz uses the ACH system to collect tax fees from a transaction total, and pay them to the proper authorities for the purpose of acting as an intermediary between tax authorities and merchants.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'H. M. Kazimi', with a stylized flourish at the end.

HANI M. KAZIMI
PRIMARY EXAMINER